REMARKS

This is a response to the Office Action of April 24, 2007. Applicants have carefully considered the rejections of the Examiner in the above-identified application. In light of this consideration, Applicants believe that the claims remain allowable. The claims have not been amended. Applicants respectfully request reconsideration of the rejection of the claims now pending in the application.

In the first Office Action of December 1, 2004, claims 1 and 8 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Claims 1-3 and 5-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,390,035, to Kasson et al. (hereinafter Kasson) in view of U.S. Patent No. 5,982,990, to Gondek (hereinafter Gondek). Claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over Kasson in view of Gondek and U.S. Patent No. 5,553,199, to Spaulding et al. (hereinafter Spaulding).

An Appeal was taken with an Appeal Brief filed December 29, 2005. Subsequently prosecution was re-opened March 31, 2006.

In the second Office Action of March 31, 2006, claims 1-16 were rejected under 35 U.S.C. §101 as directed to non-statutory subject matter. Claims 1-7 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1-5 and 7-15 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Application Publication No. 2001/0028471, to Hirokazu (hereinafter Hirokazu). Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Hirokazu in view of U.S. Patent No. 5,185,661, to Ng (hereinafter Ng). Claim 16 was rejected under 35 U.S.C. §103(a) as being unpatentable over Hirokazu in view of Kasson.

In the Office Action of September 22, 2006, claims 1-16 were rejected under 35 U.S.C. §101 as directed to non-statutory subject matter. Claims 3 and 9 were rejected under 35 U.S.C. §112, second paragraph, as being

indefinite. Claims 1-5 and 7-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hirokazu in view of Gondek. Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Hirokazu in view Gondek and Ng. Claim 16 was rejected under 35 U.S.C. §103(a) as being unpatentable over Hirokazu in view of Gondek and Kasson.

In this fourth Office Action of April 24, 2007, claims 1-5 and 7-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hirokazu in view of Gondek. Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hirokazu in view Gondek and Ng. Claim 16 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hirokazu in view of Gondek and Kasson.

The Applicant wishes to express appreciation for the withdrawal of the rejection of claims 1-16 under 35 U.S.C. §101 as directed to non-statutory subject matter. Further, the Applicant also wishes to also express appreciation for the withdrawal of the rejection of claims 3 and 9 under 35 U.S.C. §112, second paragraph, as being indefinite.

Claims 1-5 and 7-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hirokazu in view of Gondek. Hirokazu is directed to providing proof print sheets representative of a rotary press and the like. Hirokazu provides sample discreet spot color mixtures of CMYK as printed upon a proof page, and as such provides points in color space which are particular mixtures of CMYK inks only. Hirokazu does not tessellate color space into *regions* defined by ***using as vertices each*** **available ink** including at least one redundant ink (as the Applicant claims with "by using vertices representing each YMCK and the at least one additional ink, to divide the available color space into regions"). The spot colors of Hirokazu, indeed even if used as vertices (only as asserted as such in the office action, not as actually taught by Hirokazu) are much too close together in color space and in any case are not at a vertex as defined solely by a single system ink.

In other words, Hirokazu does not contemplate or teach dividing up the entire available color gamut available *for a given set of redundant ink colorants*. This is understandably so, as Hirokazu is directed to producing proof sheets for the sake of correcting color profiles where the direct observation of small colorant variations is contemplated and expected, but not the examination of the entire printer gamut. Hirokazu never addresses and thus never solves the problem of what to do with, or when to apply, redundant inks in a print system.

Gondek acknowledges the problem but only solves it empirically. Gondek while directed to redundant color inks, never-the-less fails to provide for what Hirokazu lacks and vise versa. Indeed Gondek states that the problem (which the Applicant addresses) is to be solved "empirically", (please see the discussion of this in Gondek at column 7, lines 40-57) and thus Gondek teaches away from the Applicant's teaching provided in the present Application Specification and claims. An important indicium of nonobviousness is "teaching away" from the claimed invention by the prior art. In re Dow Chemical Co., 837 F.2d 469, 473, 5 U.S.P.Q. 2d 1529, 1532 (Fed. Cir. 1988; (unpublished: In re Braat, 16 U.S.P.Q. 2d 1812 (Fed. Cir. 1990)).

The teachings of Hirokazu and Gondek used in combination will only provide the following: proof print-sheets of sample discreet spot color mixtures as achieved on a page by some combination of CMYK and redundant inks. The combination of Hirokazu and Gondek will still not address the problem of when the print system should switch from utilizing one ink to another ink when redundant inks are available, except in an empirical manner. It would thus appear that some of the Applicant's claim language is being ignored while the rest is being applied with impermissible hindsight to the prior art. The Examiner appears to be using Appellant's disclosure as a recipe for selecting the appropriate portions of the prior art to construct Appellant's claimed invention. A piecemeal reconstruction of the prior art patents in light of Appellant's disclosure is

not a basis for a holding of obviousness. In re Kamm et al., 172 U.S.P.Q. 298 (C.C.P.A. 1972). The Examiner appears to have considered various portions of the references cited, in each instance viewing the cited portion in isolation from the context of the entire reference, and combined these isolated portions to arrive at the present invention with the benefit of hindsight. Using hindsight or applying the benefit of the teachings of the present application when determining obviousness, however, is impermissible; the references applied must be reviewed without hindsight, must be reviewed as a whole, and must suggest the desirability of combining the references. Lindemann Maschinenfabrik v. American Hoist & Derrick Co., 221 U.S.P.Q. 481 (Fed. Cir. 1984). One must avoid reading the applicant's statements into the prior art - see if the prior art, without the benefit of the applicant's disclosures, would make the invention as a whole obvious. In re Sponnoble, 160 U.S.P.Q. 237 (CCPA 1969).

It is therefore respectfully requested that the rejection of claims 1-5 and 7-15 as rejected under 35 U.S.C. §103(a) be withdrawn. Allowance of claims 1-5 and 7-15 is respectfully requested.

Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hirokazu in view of Ng. Claim 16 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hirokazu in view of Kasson. Since claims 6 and 16 depend from claims deemed allowable they should be allowable as well. Allowance of claims 6 and 16 is respectfully requested.

The undersigned Xerox Corporation attorney authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025.

In the event the Examiner considers personal contact advantageous to the disposition of this case, they are hereby requested to call the undersigned attorney at (585) 423-6918, Rochester, NY.

Respectfully submitted,

/Christopher D. Wait, Reg. #43230/

Christopher D. Wait
Attorney for Applicant(s)
Registration No. 43,230
Telephone (585) 423-6918

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CDW/fsl
Xerox Corporation
Xerox Square 20A
Rochester, New York 14644